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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/041,873 | 01/07/2002 | Darryl D. Amick | MOF 304 | 4960 |
| 7590 08/18/2006 | | | | |
| Kolisch, Hartwell, Dickinson, McCormack & Heuser, PC Suite 200 520 S.W. Yamhill Street Portland, OR 97204 | | | | |
| EXAMINER WYSZOMIERSKI, GEORGE P | | | | |
| ART UNIT PAPER NUMBER | | | | |
| 1742 | | | | |
| DATE MAILED: 08/18/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,873

Applicant(s)

AMICK, DARRYL D.

Examiner

George P. Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17, 20-22, 27-31, 34-39, 41-58 and 63-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 20-22, 27-31, 34-39, 41-58 and 63-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 39 and 41-43 are objected to because it appears that the terms “actuating” and “actuated” in these claims should be changed to “activating” and “activated” respectively.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-14, 16, 17, 20-22, 27-31, 34-37, and 68-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,823,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present claims and the ‘798 claims are directed to firearms cartridges including a compacted powder of tungsten, tin, and a non-metallic binder such as a flexible epoxy, and having a density within ranges that overlap in the two sets of claims. While the ‘798 claims do not specify the casing, primer, and propellant of instant claim 1, one of ordinary skill in the art would understand any practical application of the firearms cartridges of the ‘798 claims to include such components. The ‘798 claims do not specify the “at least 50 wt% tin” and “at least 70 wt% tin” limitations of instant claims 1 and 68 respectively, and do not specify the 0.25 to 3 wt% limitation of the non-metallic binder as recited in instant claim 1. However, the ‘798 compositions encompass those containing the presently claimed amounts of tin and non-metallic binder. Thus, no patentable distinction is seen between the invention as claimed and that as defined in the ‘798 claims.

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4. Claims 38, 39, 41-51, 54-58 and 63-67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 7,059,233. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present claims and the '233 claims are directed to a process that includes compacting a mixture of powders including tungsten, a metallic binder such as tin, and a non-metallic binder to a density value as presently claimed. Claims 15 and 16 of the '233 patent further recite activating the non-metallic binder. The '233 claims do not specify the non-metallic binder is 0.25-3% of the composition or that it includes thermoset resin or epoxy. However, the processes encompassed by the '233 claims include processes involving those particular binder materials. Thus, no patentable distinction is seen between the processes as defined in the '233 claims and those as presently claimed.

5. Claims 52 and 53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 7,059,233, alone or in view of Bray et al. (U.S. Patent 6,048,379). The examiner's position is that processing materials in a manner set forth in the '233 claims, which includes processing the same materials in the same manner as presently claimed, would result in a product as useful as golf club weights or radiation shields as those processed according to the instant claims. Further, Bray column 37 indicates that tungsten-metal-nonmetal binder materials are useful in recreational applications or radiation shielding to the same extent as they are in firearms projectiles. Thus, to form the particular products recited in

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claims 52 and 53 would have been an obvious expedient to one of ordinary skill in the art practicing the process as defined in the '233 claims.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


7. The examiner has fully considered Applicant's remarks filed June 8, 2006, with respect to the Office Action mailed February 6, 2006. The examiner agrees that the previously cited art does not disclose or suggest the claimed invention, i.e. the Mravic patent does not disclose the combination of metallic and non-metallic binders in amounts presently claimed, Amick '981 does not disclose the use of a tin binder, and the West and WO '878 patents do not disclose materials and processes consistent with the instant claims. However, the claims remain rejected for reasons set forth in the new grounds of rejection, *supra*.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the new central facsimile number, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1742

GPW

August 17, 2006